

REMARKS

Claim rejections under 35 USC 103

Claims 1-3, 5, and 7-20 have been rejected under 35 USC 103(a) as being unpatentable over Shima (7,215,437) in view of Edmonds (6,748,183). Claim 4 has been rejected under 35 USC 103(a) as being unpatentable over Shima in view of Edmonds, and further in view of Wiley (2004/0137855). Claim 6 has been rejected under 35 USC 103(a) as being unpatentable over Shima in view of Edmonds, and further in view of Wu (2004/0130746).

Claims 1, 9, and 13 are independent claims, from which the remaining claims rejected on this basis ultimately depend. Applicant submits that at least as amended, claims 1, 9, and 13 are patentable over Shima in view of Edmonds, such that all the claims rejected on this basis are patentable at least because they depend from a patentable base independent claim. Insofar as the present rejection is concerned, Applicant substantially discusses claim 1 as representative of all the independent claims.

Applicant submits that the overall crux of these arguments is that the Examiner has not considered the claimed invention “as a whole” as is required – “the claimed invention as a whole must be considered” (MPEP sec. 2141.02.I.) – but rather has distilled the claimed invention down to its “gist,” which is improper. “Distilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’” (MPEP sec 2141.02.II., citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) All the claim limitations have to be considered in assessing the patentability of this claim over the prior art. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” (Id., citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)) Applicant respectfully requests that the Examiner keep this standard for patentability in mind when reviewing Applicant’s arguments below.

It is noted that in the claimed invention, a link is provided to a user operating a computing device (e.g., computer 103 of FIG. 1 of the patent application as filed), where the link corresponds to an embedded web server (EWS) of a printer. When the link is actuated by the user of the computing device, status information regarding the printer is provided. This status information is maintained by, and provided from and by, the EWS.

Shima in view of Edmonds does not teach, disclose, or suggest this. In Shima in view of Edmonds, when the user clicks an update button, status information regarding a printer is provided. (See, e.g., FIG. 8 of Shima, including update button 85.) However, note how the status information is obtained in Shima in view of Edmonds: “If the user manipulates an “Update” button 85 . . . the client computer 2 establishes an SSL communication session with the server computer 1, . . . acquires status information of the selected output destination printer, and displays it in a printer status space 86.” (Shima, col. 8, ll. 27-33.) Nowhere is it said that there is a link to an EWS of the printer, from the status information regarding the printer is provided. Rather, clicking the update button 85 merely obtains such status information from the server computer 1. (See, e.g., FIG. 1 of Shima, in which the client computer 2 establishes an SSL session with the server computer 1 to obtain this information.)

The Examiner is correct in noting that the printers in Shima in view of Edmonds directly send their own status information, but this status information is sent to the server computer, not the client computer that the user is operating. (See, e.g., Shima, col. 3, ll. 30-42.) It is also correct that a printer may maintain a web server in Shima in view of Edmonds; however, this web server is simply for accessing network-related settings for the printer, and not for the printer to maintain or send status information. (See, e.g., Shima, col. 5, ll. 32-39.) These network settings are not part of the status information that is displayed when the user clicks the button 85 in FIG. 8 of Shima. Rather, “[e]xamples of the status information . . . are ‘ready’ indicating that the printer is waiting for print job date, ‘printing’ indicating that the printer is performing a printing operation

based on print job data, and the number of print jobs being spooled.” (Shima, col. 8, ll. 33-38.) Network settings are thus not the same as status information.

It therefore cannot be said that Shima in view of Edmonds discloses displaying a link to an EWS of a printer. Shima in view of Edmonds just discloses displaying an update button on the client computer 2 of the user. When the user clicks the update button, the client computer 2 communicates with the server computer 1 to obtain printer status information. There is no link to an EWS of a printer here; at best there is just a link to the server computer 1 that maintains the status information of the printer. (See, e.g., steps 704 and 705 in FIG. 7 of Shima.) There is no disclosure, teaching, or suggestion in Shima in view of Edmonds that the server computer even obtains this status information from the EWS of the printer, or that the EWS maintains the status information. Shima in view of Edmonds simply states that printers directly send status information to the server computer (Shima, col. 3, ll. 30-42), and that the web server of a printer is just used for specifying network-related settings of the printer, not for obtaining status information (Shima, col. 5, ll. 32-39).

To differentiate the claimed invention even more from Shima in view of Edmonds, the independent claims have been amended wherein “the EWS of the printer *directly* communicates with the computing device operated by the user through a network and does *not* communicate with the computing device through any server computing device.” For example, in FIG. 1 of the patent application as filed, the EWS 112 and 132 of the printers 104 and 130, respectively, communicate with the computer 103 directly over the network 118. The EWS 112 and 132 do not thus communicate with the computer 103 through the server 110.

By comparison, in Shima in view of Edmonds, as has been discussed above, the computing device of the user receives status information regarding a printer from a server computing device. Thus, the printer does not directly communicate with the computing device of the user over a network, but rather the printer directly communicates with a server computing device, and the computing device of the user directly communicates with the server computing device. For

example, the printer 3 in FIG. 1 of Shima communicates directly with the server computer 1 over the network, and the client computer 2 communicates directly with the server computer 1 over the network. By comparison, the printer 3 does not directly communicate with the network printer 3 over the network in Shima in view of Edmonds.

Finally, Applicant notes that the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 550 US _____ (2007), has stated that examiners “may identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” (*KSR*, at 15.) This is the case here, where the Examiner has stated that the reason to modify Shima per Edmonds per the claimed invention is that “such a modification would allow a user to specify various parameters for printing.” (Office action, p. 4.) However, this reason does not actually prompt one of ordinary skill within the art to combine the elements of Shima and Edmonds to yield the claimed invention.

Indeed, Shima already permits a user to specify “various parameters for printing,” without the need for further modification per Edmonds. For example, Shima shows in FIG. 10 that a user can already specify such printing parameters in box 82. Therefore, if the goal is simply to allow a user to specify various parameters for printing, there is no need to modify Shima per the teachings of Edmonds. Stated another way, this reason does not actually prompt one of ordinary skill within the art to combine the elements of Shima and Edmonds “in the way the claimed new invention does,” to use the words of the Supreme Court in *KSR*. Without more, then, the Examiner’s stated reason to modify Shima in view of Edmonds to yield the claimed invention fails to meet the requirements articulated by the Supreme Court in *KSR*.

For all of these reasons, Applicant respectfully submits that the independent claims are patentable over Shima in view of Edmonds.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicant's representative, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



Michael A. Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

Law Offices of Michael Dryja
1474 N Cooper Rd #105-248
Gilbert, AZ 85233
tel: 425-427-5094
fax: 425-563-2098